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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,849	01/14/2002	Nicholas P. Van Brunt	12653-13	8532

1346 7590 08/13/2003

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EXAMINER

DEMILLE, DANTON D

ART UNIT PAPER NUMBER

3764

DATE MAILED: 08/13/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/055,849

Applicant(s)

VAN BRUNT ET AL.

Examiner

Danton DeMille

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-119 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-119 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-119 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,769,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because every limitation found in the claims is also found. It would have been obvious to leave out the details of the crankshaft and seal for example.

Claims 13-119 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Every one of the newly added independent claims has broadened the scope of the claims by eliminating the limitation of “a continuous air flow generator”. Every claim has eliminated this limitation all together or replaced “a continuous air flow generator” with --a positive air flow generator--. This limitation of “a continuous air flow generator” was specifically added in amendment B dated 6 July 1999 to overcome the prior art. Specifically applicant stated on page 4 of the 6 July 1999 response “[C]laim 1, as amended, includes limitations not found in Warwick et al. First, Warwick does not disclose a ‘continuous air flow generator...’” and gave reasons why the storage tank 130 of Warwick “does not provide, and is not capable of providing, a continuous, baseline pressure as does the continuous air flow generator of the present claimed invention.” In fact applicant’s amendment replaced the language “a positive air flow generator” with “a continuous air flow generator”. Broadly, the air flow generator of Warwick is a “positive” air flow generator because it provides positive air pressure to the bladder. The word “continuous” was added to help define over a “positive” air flow generator by highlighting the continuous nature of the air flow generator using first and second feedback control means to maintain a continuous peak pressure at a predetermined value. Applicant is now trying to revert back to the “positive air flow generator” originally claimed before the noted amendment. In fact the only difference between patent claim 1 and the new claim 13 is replacing “a continuous air flow generator” with --a positive air flow generator-- undoing that which was specifically

changed by amendment. Every thing else is the same. Applicant would appear to be attempting to recapture that which was given up in the prosecution of the patent.

Furthermore, claims 20, 32, 44, 45, 78, 90, 91 and 101 have eliminated the limitation to the first and second feedback and control means recited in the last two subparagraphs of claim 1 of the patent. Amendment B filed 6 July 1999 also added the first and second feedback and control means to help further define over the prior art. Applicant at the top of page 5 argued "Next, Warwick et al. does not disclose either the first or second feedback and control means found in claim 1" and provides reasons why Warwick doesn't teach these limitations.

***Claim Rejections - 35 USC § 103***

Claims 32-41, 44-89, 91-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norton et al. 3,878,839 in view of Hayek 4,930,498. It would appear that broadly Norton teaches an oscillatory air flow generator including an air chamber 16, a reciprocating piston shown in figure 13, a first motor 76 and a positive air flow generator. Conventional piston pumps are well known to the artisan of ordinary skill. Piston pumps including a flexible diaphragm is also conventional and an obvious equivalent alternative piston pump. Hayek teaches this convention in column 5 lines 3-16 "[s]aid piston member may be a flexible diaphragm secured around an edge region thereof to close a pump chamber and having a central region which is reciprocable to pump air to and from pump chamber".


Norton also teaches a frequency-compensation feedback system in figure 13 including the R-wave sensor and control 83 and EKG monitor 82. This system includes sensors that monitor the patients heart rate and continuously adjusts the frequency of the oscillatory air flow based on the feedback from the EKG. Broadly this would appear to comprehend the claimed

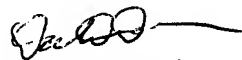
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frequency-compensation feedback system because it continuously adjusts the frequency of the oscillations to maintain the frequency at a predetermined value which is the heart rate of the patient.

Norton also teaches that the pressure in the system can be adjusted by adjusting the volume by adjusting valve 78 which supplies air from air pump 79 to the system column 10 lines 47-56. Providing an automated system to maintain the pressure at the desired level to produce optimum hemodynamic results would have been an obvious provision. Hayek also teaches in column 6, line 62-column 7, line 2 use of pressure sensors for sensing the pressure in the system and appropriate electronic circuitry for controlling the system to maintain the desired pressure. It would have been obvious to one of ordinary skill in the art to modify Norton to use flexible diaphragm as taught by Hayek as an obvious equivalent alternative piston type pump and to use electronic circuitry to maintain the desired pressure in the system as also suggested by Hayek to achieve optimum pressure on the patient.

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